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09/893,504	06/29/2001	Hirotsugu Kawada	2001_0920A	6297

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WENDEROTH, LIND & PONACK, L.L.P.  
2033 K STREET N. W.  
SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER

SHIFERAW, ELENI A

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/893,504

Applicant(s)

KAWADA ET AL.

Examiner

Eleni A. Shiferaw

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/12/2006 has been entered.

### *Response to Amendment and Argument*

2. Applicant's amendments and arguments with respect to amended claims 1, 4-7, and 10, and presently pending claims 1-13 have been considered but are not persuasive.

The Applicant's first argument concerns none of the references (Osada et al., Hurtado et al., Benaloh, Shear, and Quinnett) disclose wherein "*the second writing unit that, when the optical disk is for industrial use, generates not only the second area for industrial use, but also the first area for consumer use and writes the message data which, when reproduced, informs the user that the content recorded on the optical disk cannot be reproduced by a consumer reproduction apparatus, to the first area*" as amended and recited in claims 1, 4-7, and 10, (remark page 12 lines 17-21, page 13 lines 29-page 14 lines 10 and page 14 lines 20-27, page 15 lines 9-14, page 15 lines 24-29, page 16 lines 23-page 17 lines 15). The examiner respectfully disagrees with the Applicant's contentions and would like to draw the Applicant's attention to col. 8 lines 67, claim 1 line 10, and fig. 6 wherein Osada teaches a video disk recorder recording first user data A (consumer use) and second user data B (industrial use) in two sectors of an

optical disk and repeatedly recording copy right protection to inhibit copy more than once for all the sectors. Even though it would have been obvious at the time of the invention to modify Osada et al.'s copy protection message data to display information to inform the user whether the disk is for industrial use or consumer use because the user would not think that the disk if faulty, the examiner combined a reference Hurtado et al. that discloses copy protection for restrictions imposed on the use of content (see, par. 0246-0248, and fig. 5 elements 517, 523 and 525) and displaying message data information, for the copy protection, by the user the device to inform the user that the content cannot be copied/displayed by the user device and displaying reasons, to why it is unable to render/copy the data, to inform the user (see, 0471, 0467-0471). It is clear that Hurtado does in fact teach message data information generated by the user device to inform the user that the content cannot be reproduced/copied/rendered as recited in claims 1, 4, 5-7, and 10.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-8, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osada et al. (Osada, Patent No.: US 6,477,127 B1) in view of Hurtado et al. (Hurtado, Pub. No: US 2003/0105718 A1) and Benaloh (Patent No.: US 6,886,098 B1).

As per claims 1, 4-5, 7, and 10; Osada teaches a recording apparatus/method/disk/medium for recording digital content onto an optical disk which has a first entry area and a second entry area, the first entry area being an area that is to be first accessed when the optical disk is loaded to a consumer reproduction apparatus, and the second entry area being an area that is to first accessed when the optical disk is loaded to an industrial reproduction apparatus (claim 1), the recording apparatus comprising:

an accepting unit operable to accept from a user an indication whether the optical disk is for consumer use or industrial use (col. 14 lines 16-32, col. 6 lines 15-44, and fig. 6; *optical disk I accepted to record first user data or user data A, and second user data or user data B is recorded*);

a first writing unit operable to, when the optical disk is for consumer use, (a) write the digital to the optical disk, and (b) write a jump command which designates the digital content as a jump destination, to the first entry area (col. 6 lines 15-44, col. 4 lines 12-14, and fig. 6 element user data A) and on which the message data reproducible by the consumer reproduction apparatus is recorded (col. 6 lines 15-44, col. 4 lines 12-14, and fig. 6 element user data A); and

a second writing unit operable to, when the optical disk is for industrial use, (a) write the digital content and message data to the optical disk, (b) write a jump command which designates the message data as a jump destination, to the first entry area (col. 8 lines 63-67), and (c) write a jump command which designates the encrypted digital content as a jump destination, to the second entry area (col. 6 lines 15-44 and lines 54-62, col. 4 lines 12-14, and fig. 6 element user data B),

Osada teaches a video disk recorder recording first user data and second user data in two sectors and repeatedly recording copy right protection to inhibit copy more than once for all the sectors (col. 8 lines 67, claim 1 line 10). Osada does not explicitly teach wherein the message data includes information which is reproduced by the consumer reproduction apparatus such that the consumer reproduction apparatus informs a user of the consumer reproduction apparatus that the encrypted digital content cannot be reproduced by the consumer reproduction apparatus, and using a first content key that is to be encrypted using a non-unique key which is not unique to the customer reproduction apparatus when the optical disk is for consumer use as amended.

However Hurtado teaches copy protection for restrictions imposed on the use of content (par. 0246-0248, and fig. 5 elements 517, 523 and 525), and **displaying message data information, for the copy protection, by the user the device to inform the user that the content cannot be reproduced/copied/displayed by the user device and displaying reasons, to why it is unable to render/copy the data, to inform the user** (see, 0471, 0467-0471) that reads on wherein the message data includes information which is reproduced by the consumer reproduction apparatus such that the consumer reproduction apparatus informs a user of the consumer reproduction apparatus that the encrypted digital content cannot be reproduced by the consumer reproduction apparatus,

using a first content key that is to be encrypted using a non-unique key which is not unique to the customer reproduction apparatus when the optical disk is for consumer use as amended (par. 0166, 0248, 1031, **0253**, and 0158-0159; *content-key is encrypted using a key, and content is encrypted using a non-unique key that is content is not played only on one playing apparatus instead a content is played on various devices of a particular user*).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Hurtado within system of Osada because they are analogous in securely recording and/or reproducing digital data (par. 0179 and 0232). One would have been motivated to incorporate the teachings of Hurtado within Osada **because it would inform the user to why the content is not reproduced clearly so the user would understand clearly why the content is not reproduced** (par. 0071) and would secure content by encrypting the content key by another key.

Osada and Hurtado fail to explicitly teach an encrypting unit operable to encrypt the digital content using a second content key that is to be encrypted using a unique key which is unique to the industrial reproduction apparatus when the optical disk is for industrial use;

However **Benaloh** discloses an encrypting unit operable to encrypt the digital content using a second content key that is to be encrypted using a unique key which is unique to the industrial reproduction apparatus when the optical disk is for industrial use (col. 7 lines 13-21, and lines 42-col. 8 lines 5; *unique device key encrypting content key, that encrypts content, content key is accessed by authorized content player only*). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Benaloh within the combination system of Osada and Hurtado because they are analogous in digital content (col. 3 lines 43-55). One would have been motivated to incorporate the teachings of Benaloh within the system of Osada to enhance security by restricting a content player device as the only device to access the content (col. 8 lines 1-5).

As per claim 6, Osada teaches an optical disk which has a first entry area and a second entry area and on which digital content is recorded, wherein

the first entry area is an area to be first accessed when the optical disk is loaded to a consumer reproduction apparatus, the second entry area is an area to be first accessed when the optical disk is loaded to an industrial reproduction apparatus (col. 21 lines 59-62, col. 6 lines 15-44, and col. 4 lines 12-14),

a jump command that designates message data reproducible by the consumer reproduction apparatus as a jump destination is written in the first entry area, (col. 6 lines 15-44, col. 4 lines 12-14, and fig. 6 element user data A), and

a jump command that designates the digital content as a jump destination is written in the second entry area (col. 6 lines 15-44 and lines 54-62, col. 4 lines 12-14, fig. 6 element user data B, and col. 21 lines 59-62), and

Osada teaches a video disk recorder recording first user data and second user data in two sectors and repeatedly recording copy right protection to inhibit copy more than once for all the sectors (col. 8 lines 67, claim 1 line 10). Osada does not explicitly teach wherein the message data includes information which is reproduced by the consumer reproduction apparatus such that the consumer reproduction apparatus informs a user of the consumer reproduction apparatus that the encrypted digital content cannot be reproduced by the consumer reproduction apparatus.

However Hurtado teaches copy protection for restrictions imposed on the use of content (par. 0246-0248, and fig. 5 elements 517, 523 and 525), and **displaying message data information, for the copy protection, by the user the device to inform the user that the content cannot be reproduced/copied/displayed by the user device and displaying reasons,**



**to why it is unable to render/copy the data, to inform the user** (see, 0471, 0467-0471) that reads on wherein the message data includes information which is reproduced by the consumer reproduction apparatus such that the consumer reproduction apparatus informs a user of the consumer reproduction apparatus that the encrypted digital content cannot be reproduced by the consumer reproduction apparatus,

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Hurtado within system of Osada because they are analogous in securely recording and/or reproducing digital data (par. 0179 and 0232). One would have been motivated to incorporate the teachings of Hurtado within Osada **because it would inform the user to why the content is not reproduced clearly so the user would understand clearly why the content is not reproduced** (par. 0071).

Osada and Hurtado fail to explicitly teach discloses wherein the digital content is recorded in a form of being encrypted using a second content key that is to be encrypted using a unique key which is unique to the industrial reproduction apparatus;

However **Benaloh** discloses wherein the digital content is recorded in a form of being encrypted using a second content key that is to be encrypted using a unique key which is unique to the industrial reproduction apparatus, (col. 7 lines 13-21, and lines 42-col. 8 lines 5; *unique device key encrypting content key, that encrypts content, content key is accessed by authorized content player only*). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Benaloh within the combination system of Osada and Hurtado because they are analogous in digital content (col. 3 lines 43-55). One would have been motivated to incorporate the teachings of Benaloh within the system of

Osada because it would enhance security by restricting a content player device as the only device to access the content (col. 8 lines 1-5).

As per claims 2, 8, and 11, Osada, Hurtado and Benaloh teach all the subject matter as described above. In addition the combination teach an apparatus/method/medium, for a system that includes a first key management center and a second key management center and encrypts a second key and content, and for recording the encrypted content key and the encrypted content to the optical disk to be accessed by a reproduction apparatus,

wherein the reproduction apparatus decrypts the encrypted content key, and decrypts the encrypted content using the decrypted content key (Hurtado: par. 0220; step 417-418; *decrypting the encrypted key and using the decrypted key decrypting the encrypted content*),

wherein the industrial reproduction apparatus decrypts the encrypted second content key using the unique key provided from the second key management center, to obtain the second content key (Benaloh col. 8 lines 12-32; *decrypting the encrypted unique device key to decrypt the encrypted content*),

wherein the consumer reproduction apparatus retrieves the non-unique key from the optical disk, and decrypts the encrypted first content key using the non-unique key to obtain the first content key (Hurtado: par. 0557, and 0220; step 417-418),

wherein the first key management center encrypts the first content key using the non-unique key (Hurtado: par. 0166, 0248, 1031, and 0158-0159; *content is encrypted using a non-*

*unique key that is content is not played only on one playing apparatus instead a content is played on various devices of a particular user),*

wherein the second key management center encrypts the second content key using a public key corresponding to the unique key, and provides the unique key to the industrial reproduction apparatus (Benaloh: col. 7 lines 13-21, and lines 42-col. 8 lines 5; *unique device key encrypting content key, that encrypts content, content key is accessed by authorized content player only*),

wherein the first writing unit writes the non-unique key and the encrypted first content key to the optical disk (Hurtado: par. 0740, 0557, 0166, 0248, 1031, and 0158-0159), and

wherein the second writing unit writes the encrypted second content key to the optical disk (Benaloh: col. 4 lines 66-col. 5 lines 24, and col. 7 lines 13-21, and lines 42-col. 8 lines 5).

The rationale for combining are the same as claim 1 above.

4. Claims 3, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osada et al. (Osada, Patent No.: US 6,477,127 B1) in view of Hurtado et al. (Hurtado, Pub. No: US 2003/0105718 A1), and Benaloh (Patent No.: US 6,886,098 B1), and further in view of Quinnett et al. (Quinnett, Patent No.: US 6,615,160 B1).

As per claims 3, 9, and 12, Osada, Hurtado and Benaloh teach all the subject matter as described above. Osada, Hurado and Benaloh do not teach an apparatus/method/medium, wherein the message data, indicating the digital content cannot be reproduced by the consumer reproduction

apparatus includes a plurality of character strings which are each written in a different language. However **Quinnett** teaches displaying message on the screen in different language (Quinnett Col. 4 lines 13-23). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Quinnett with in the combination system of Osada, Hurtado and Benaloh because it would allow to display messages in different language that people who speak different language could understand the copyright message.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osada et al. (Osada, Patent No.: US 6,477,127 B1) in view of Hurtado et al. (Hurtado, Pub. No: US 2003/0105718 A1), and Benaloh (Patent No.: US 6,886,098 B1), and further in view of Shear et al. (Shear, Pub. No.: US 2001/0042043 A).

Regarding claim 13, Osada, Hurtado, and Benaloh teach all the subject matter as described above and Osada specifically disclose reproducing digital content on a disk, a first user section and second user section, which reads on industrial use and consumer user as cited above.

The combination fail to explicitly teach the industrial use and consumer use as amended.

However Shear discloses the recording apparatus:

wherein the optical disk is made available for use at a start of or during a release of the digital content at theaters, when the optical disk is for industrial use (Shear par. 0087; *digital content stored on an optical disc is used for theater use/industrial use*), and

the optical disk is made available for use after the release of the digital content at theaters ends, when the optical disk is for consumer use (Shear par. 0087; *digital content stored on an optical disc is used for personal use/consumer use*).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of theater/industrial use and personal/consumer use of the content with in the system of user data A and user data B of Osada, Hurtado, and Benaloh because it would give access to different users. One would have been motivated to incorporate the teachings of Shear within the combination system to securely provide restricted and/or provide access to plurality of users.

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,832,319 B1 Bell et al. **teaches encrypting content/media key with unique device key and content key ciphering digital content (col. 3 lines 15-50).**

For more prior art of record please see Form 892.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

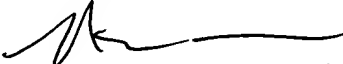
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.S.

  
September 26, 2006

NASSER MOAZZAMI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
9,26,06